

REMARKS**Rejection under 35 USC 103**

Claims 1-25, 29, 30, and 32-38 stand rejected under 35 U.S.C. §103(a) as unpatentable over Martin et al., U.S. Pat. No. 6,397,189. In support of the rejection, the Office Action provides:

“Martin discloses that digitally distributed entertainment system that may accept payment for services or entertainment units 13 culling content from a master list 27 and a subset of the master list (a local list 93) that is distributed over Article A LAN from a host computer that comprises a wide area network (WAN) 11.

To have provided a personal computer having a graphical user interface connected to a WAN and LAN and download content from a master list for Martin would have been obvious to one of ordinary skill in the art. Doing such would implement a content download from the well known graphical user interface system. Regarding the particular entertainment unit and peripheral services, e.g., local memory device, the particular user interface and couplings, infrared readers, payment device, activity logs, would have been an obvious design choice for one of ordinary skill in the art as such components/technology or common knowledge at the time of applicant’s invention.”

Applicants disagree.

There are a significant number of differences between the devices and methods found in the claims and the devices and methods found in Martin et al. Applicants do not disagree with the explanation of the Martin et al patent found in the Office Action. However, applicants would like to emphasize one particular feature found in each of the claims and relating to the way in which a song (or more generally “entertainment content”) is provided to a user when that user requests entertainment content not stored in the entertainment unit operated by the user. In each of the independent claims, may be found limitations drawn to the following concept: if a user requests entertainment content that is not on the entertainment unit associated with his or her user interface, but the desired entertainment content is instead found on the “central resource,” then the central resource passes that item of entertainment content to the entertainment unit where, if desired, it may

be immediately used, played, or performed. In a functional sense, this empowers the user with control over the acquisition of those remotely stored songs and games: the user controls both the acquisition of the song or entertainment content and furthermore controls the time of that delivery.

Such a concept is not found in the Martin et al patent. In general, the Martin et al system plays only those songs that are stored locally in response to a user request.

Specifically, the Martin et al device appears to utilize a “computered jukebox 13 [that] plays songs and displays graphics which are stored locally in the large volume data storage unit 93.” There is no mention of the concept of playing a song found only in the master library 27 residing in the central management system 11. Martin et al’s disclosure relating to the way in which songs are sent to the jukebox may be found beginning in the paragraph in column 4, beginning about line 63. Towards the end of that paragraph, on column 5, may be found: “both the song library 91 and the associated catalog 95 are monitored and updated by the central management system 11 as needed via transmission link 15. The jukebox 13 permits this monitoring and updating at any time with no impact on its end-user performance.” This speaks to the manner in which new songs may be introduced to the local unit by the central management system.

Further, Figures 4A and 4B contain flowcharts that illustrate the way in which songs are provided to jukebox 13. The paragraph explaining Figures 4A and 4B, found at column 5, beginning at line 43, provides a very detailed account of how songs are downloaded from management system 11 to jukebox 13, but that disclosure does not mention the idea of using a customer request as the basis for an instruction to directly send a song to the jukebox. There is a mention of considering “customer request for new songs,” but it is only to “enter song request data as discussed below.” See lines 56-57.

This customer input for new songs is discussed in column 6 with relation to Figure 5 beginning at line 39. In summary, the patent mentions that, during a period of time when no song selection is playing, the processing circuit 121 operates in a “user attract mode, displaying a random sequence of available graphic images....” It is only during this “attract mode” that a “prompt requesting customers to enter new song requests” is found. The customer’s desire for new music is

treated in the following way: “the new song request data entered by a customer using the keyboard is stored and uploaded to the management system 11 to aid that system 11 in determining whether new song data should be downloaded to the jukebox.” [Emphasis added]. See column 6, lines 59 and following. As discussed elsewhere in the patent, the central management system 11 includes criteria that assesses, *inter alia*, such new song requests as a portion of the data compiled to determine whether to download the requested song or not. Apparently, some later customer enjoys the benefit of an earlier customer requesting a new song, but only if the song meets the criteria managed by the central management system 11.

To clarify the differences: a customer’s request in the Martin et al patent system is used along with various other data to allow the central management system 11 to determine whether to download a particular song or not. The claims under consideration here, however, place that customer or user in the pilot seat insofar as controlling both whether and when a song is downloaded to the entertainment unit. Applicants’ claimed devices and methods place the control in the customer-user rather than in resolution of the management system’s criteria. This feature is significant and this feature is not suggested in any variation of the Martin et al technology discussed in the patent.

As noted above, these claims recite devices and methods having significant differences from the devices and methods otherwise found in Martin, et al. We have discussed but one major difference here.

Withdrawal of the rejection is therefore requested.

RIGHT OF PRIORITY UNDER 35 USC 119

Applicants note that in an earlier Office Action, the priority to the provisional application was denied on the basis of an error in the Declaration in which priority under 35 USC 119(**h**) was requested, rather than properly under 35 USC 119(e). It is not clear whether priority to the

provisional application has since been properly acknowledged. Applicants believe that denial of the priority was improper, even though citation of a fictitious statute was had in the Declaration.

The statute, 35 USC 119(e)(1), on this point, requires for benefit of that provisional filing date only that "... the application for patent[be] filed not later than twelve months after the date on which the provisional application was filed and ... [contains or be] ... amended to contain a specific reference to the provisional application." In this instance, the instant utility patent application contained the following paragraph when filed:

"This application claims priority from United States Provisional Patent Application serial number 60/145,607, filed July 26, 1999."

The quoted paragraph completely meets the requirement of the law.

Furthermore, the Rules (i.e., 37 CFR 1.63) do not require that an applicant include in the Declaration a priority claim to a provisional application. It is not a requirement either under the Patent Statute or under the Code of Federal Regulations that the Declaration even identify a "parent" provisional application in the Declaration, much less present a claim for priority there. Consequently, the citation of a non-existent statutory section in the Declaration, cannot be a basis for denying priority. Since the Patent Statute does not make a requirement that the applicant identify the provision of the law under which priority of a provisional filing date is made, the USPTO lacks the authority to require an applicant to identify the statute, and then to deny the priority if the statute is mis-identified.

It should also be noted that both the Declaration and the specification properly identified the provisional application by serial number, and in each document, the words made a claim for priority -- in words -- based upon that properly identified provisional. It cannot be reasonably urged that there is confusion by the PTO about what applicants are requesting -- even when a fictitious statute provision is listed -- when a proper provisional application serial number is used is a sentence "requesting" priority. What else could it mean?

Applicants request acknowledgement of the priority claim to the provisional application identified in the specification.

SUMMARY

Applicants have responded to each matter of substance found in the Office Action. If the Examiner would like to discuss the rejection or would otherwise like to conduct an interview to hasten the application toward issuance, he is urged and invited to contact the attorney at the number listed below. Allowance is requested.

In the unlikely event that the USPTO determines that an extension or other relief is required as a result of this document, Appellants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and other fees due to our Deposit account no. 03-1952 referencing Docket No. 566472000100. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

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